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REMARKS

By the Advisory Action mailed March 17, 2004, (Paper No. 0315) claims 1, 2 and 4-40 are pending and stand rejected. In response, Applicant amends the specification and claims as described in detail below. Upon entry of the present response and amendment, claims 1-2 and 4-40 are pending. Applicant respectfully requests that the amendment be entered because the amendment places the claims in condition for allowance or reduces the issues for appeal.

The Advisory Action indicated that the addition of new claim 41 rendered the amendment prima facie not enterable. Accordingly, this Response does not include the addition of any new claims and in particular does not include claim 41 proposed in the previous Response. Because the previous amendment was not entered, proposed claim 41 is not pending. Claims 14-16 are amended to cure the indefiniteness identified regarding the recitation of "the enhancement technique". With regard to claims 22 and 24, Applicant has replaced the second occurrence of the term "enclosure" with --assembly--.

Applicant notes the Advisory Action did not reference the status of the 35 U.S.C. § 103 rejections. Accordingly, Applicant assumes that Applicant's prior Response, if entered, would traverse these rejections. Since the prior Response was not entered, Applicant re-presents its Response to these rejections. Applicant believes the present response is fully responsive to all outstanding issues raised by the Examiner.

1. Amendments to the Specification

The specification is amended to correct matters of form.

2. Rejections under 35 U.S.C. § 112, second paragraph

Claims 4-16, 19, 20, 22-24, 27-37, and 40 are rejected under 35 U.S.C. § 112, first paragraph as allegedly indefinite for a variety of reasons. Applicant has amended each claim to address the rejection.

Claim 4 is amended to replace the term "enclosure" with the term --assembly--.

Claims 8-10 and 12 are amended to replace the term "medium" with the term --matrix-- and add the term "wherein".

Claim 11 is amended to depend from claim 10, and to insert the term --wherein--.

Claim 13 is amended to depend from claim 1, and to replace the term "media element" with --the exchange matrix--.

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Claim 14 is amended to recite "further comprising an electrohydrodynamic enhancement technique".

Claim 15 is amended to depend from claim 14.

Claim 16 is amended to recite "further comprising a media shuffling enhancement technique".

Claim 19 is amended to replace the term "media" with the term --exchange matrix--.

Claim 20 is amended to depend from claim 2, and to replace the term "media" with the term --exchange matrix--.

Claim 22 is amended to replace the term "enclosure" with the term --assembly--.

Claim 23 is amended to replace the term "media" with the term --exchange matrix--.

Claim 24 is amended to replace the term "media element" with the term --exchange matrix-- and to replace the term "enclosure" with the term --assembly--.

Claim 25 is amended to insert after the term "exchange matrix", the term --element--.

Claim 27 is amended to replace the term "media" with the term --exchange matrix--.

Claim 28 is amended depend from claim 26 and to replace the term "media" with the term --exchange matrix--.

Claim 29 is amended to replace the term "the sealing force" with the term --a sealing force--.

Claim 30 is amended to replace the term "media" with the term --exchange matrix element--.

Claim 31 is amended to delete the term "said" immediately before the term --first-- and to insert the word --having--. Claim 31 is also amended to delete "the first stream having a lower potential of the species than the second stream, the species transfer device capable of transferring a portion of the species from the second stream to the first stream".

Claim 32 is amended replace the term "said" with --further comprising a--.

Claims 34, 35, and 37 are amended to replace the term "medium" with the term --matrix element--.

Claim 40 is amended to include a period at the end of the claim, replace the first instance of "and" with --an--, delete the term "I", and insert --comprises-- before "a ceramic medium".

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Applicant submits that these amendments do not constitute new matter and place the claims in condition for allowance.

3. Rejection of the Claims under 35 U.S.C. § 103

Claims 1, 2, 4, 5, 7-22, 25, 26 and 34-40 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over DuBose (U.S. Patent No. 6,013,385) in view of Siggelin (U.S. Patent No. 3,176,446). Claims 6 and 27 are also rejected over DuBose in view of Siggelin and U.S. Patent No. 6,521,026. Claims 23 and 30 are rejected over DuBose in view of Siggelin and U.S. Patent No. 3,183,649. Claims 24, 28, and 31-33 are rejected over DuBose in view of Siggelin and U.S. Patent No. 3,780,498. Claim 29 is rejected over DuBose in view of Siggelin and U.S. Patent No. 2,617,986. Applicant respectfully traverses this rejection because DuBose is not a proper reference and the USPTO has failed to establish a prima facie case of obviousness.

A. Relevant Law

35 U.S.C. § 103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

B. Analysis

The Office Action notes that Applicant's prior submission of a Statement of Common Ownership with the previous Response was ineffective to disqualify the DuBose reference as prior art because the DuBose reference is a proper reference under 35 U.S.C. § 102(e). Applicant respectfully requests reconsideration.

As noted in a telephone conference between the undersigned and the Examiner on February 12, 2004, the inventive entities between the present application and the DuBose reference are different. Accordingly, the DuBose reference is "by another person" in accordance with 35 U.S.C. § 103(c). Moreover, the Office Action concedes that the DuBose reference qualifies as prior art under 35 U.S.C. § 102(e), also in accordance with the above-referenced statute.

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In the previous response by Applicant, Applicant provided a statement by co-inventor Ron DuBose indicating that at the time the present invention was made, U.S. Patent No. 6,013,385 (the DuBose reference) and the present application were commonly-owned or under an obligation to be assigned to the same entity.

MPEP 706.02(l)(2) provides in pertinent part:

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Therefore, in view of the Statement of Common Ownership previously submitted (a copy of which is attached), Applicant respectfully submits that common ownership between the present application and the DuBose reference at the time the invention was made has been established.

Applicant respectfully submits that the DuBose reference is therefore, disqualified as prior art under 35 U.S.C. § 103(c) because the DuBose reference is "by another person", qualifies as prior art on under one or more sections (e), (f) and (g) of Section 102, and the present application and the DuBose reference were commonly owned or under an obligation of assignment to the same person at the time the invention was made.

Because all of the obviousness rejections are premised on the DuBose reference as a primary reference and the DuBose reference is disqualified as prior art under 35 U.S.C. § 103(c), the obviousness rejections have been overcome for at least the reason that the remaining references fail to teach or suggest each element of the claimed subject matter.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, and 4-40 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

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